

REMARKS/ARGUMENTS

The non-final Office Action mailed May 6, 2003 has been carefully reviewed, and the present remarks are responsive thereto. Applicant herein amends claim 39. Claims 1-40 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

Art-Based Rejections

Claims 1-7, 11, 12, 16-26, 30, 31 and 35-40 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,476,834 to Doval et al. (“Doval”). Dependent claims 14 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Doval in view of U.S. Patent No. 5,502,803 to Yoshida et al. (“Yoshida”). Dependent claims 15 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Doval in view of U.S. Patent No. 6,307,956 to Black et al. (“Black”). Dependent claims 8, 9, 27 and 28 are rejected 35 U.S.C. § 103(a) as being unpatentable over Doval in view of U.S. Patent No. 6,535,897 to Altman et al. (“Altman”). Dependent claims 10, 13, 29 and 32 are rejected 35 U.S.C. § 103(a) as being unpatentable over Doval.

Doval describes a system using a writing surface where users draw selectable items such as buttons with text inside and symbols, which can then be actively selected to initiate a function (Doval, Abstract). The system in Doval presents a method whereby, upon selection or initiation, handwritten or hand-drawn text, symbols, frames and other shapes can be recognized by the system (Doval, col.1, lines 55-60).

Claim 1 is directed to a method for detecting an in-air gesture. The method of claim 1 comprises, *inter alia*, “recording positional information of the digitizing pen with respect to the surface of the digitizing writing surface within a moving buffer...and when the digitizing pen is determined to be in motion with respect to the digitizing writing surface, the moving buffer

recording a predetermined amount of positional information spanning a predetermined amount of time....”

Doval does not teach a moving buffer as recited in claim 1. The Office Action appears to regard element 300 of Doval as a moving buffer. However, Doval discloses only that element 300 contains software, functions, processes, applications or programs (Doval, col. 4, lines 5-7). None of these are a moving buffer, nor do they inherently require a moving buffer. For at this reason, claim 1 is allowable over Doval.

Independent claim 20 is also allowable over Doval for at least similar reasons as those set forth above with regard to claim 1, and further in view of the additional features recited therein.

Claims 2-19, which depend from claim 1, and claims 21-38, which depend from claim 20, are also allowable over Doval for at least those reasons set forth above with regard to their respective independent claims, and further in view of the additional features recited therein. Moreover, none of the other asserted references (i.e., Yoshida, Black, and Altman), either alone or in combination with Doval, teach or suggest a moving buffer as claimed. Therefore, without conceding the propriety of the proposed combinations of references, claims 14 and 33 are allowable over Doval in view of Yoshida, claims 15 and 34 are allowable over Doval in view of Black, and claims 8, 9, 27, and 28 are allowable over Doval in view of Altman.

Also, the Office Action alleges that determining whether positional information recorded in the moving buffer corresponds to the predetermined in-air gesture is based on a relative position of the starting point with respect to the ending point, as recited in claims 10 and 29, is an obvious modification to Doval. The Office Action further alleges that determining whether positional information recorded in the moving buffer corresponds to a predetermined in-air gesture is based on a detected motion speed, as recited in claims 13 and 32, is also an obvious

modification. The Office Action has attempted to improperly piece together the invention using Applicant's own disclosure as a roadmap.

As held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual or “template” to piece together* the teaching of the prior art … [o]ne cannot use hindsight construction to pick and choose among isolated disclosures … to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). Yet this is exactly what the Office Action is attempting to do, but even worse; the prior art does not even teach the pieces.

The Office Action also does not provide evidence of a teaching, motivation, or suggestion in the prior art to select and combine these pieces, and therefore has not met its burden of creating a *prima facie* case of obviousness. The U.S. Court of Appeals for the Federal Circuit recently vacated a decision of the Board of Patent Appeals and Interferences of the USPTO rejecting claims of the applicant based on a conclusory determination of obviousness. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). According to the Federal Circuit, the standard requires “[w]hen patentability turns on the question of obviousness, the search and analysis of the prior art includes evidence relevant to the finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness”(underlining added). *Id.* at 61 USPQ2d 1433. The Federal Circuit went on to say that “[o]ur case law makes clear that the best defense against the subtle, but powerful attraction of hindsight based obviousness analysis is a rigorous application of the requirement of a showing of the teaching or motivation to combine prior art references.” *In re Lee*, 61 USPQ2d at 1433 (quoting, *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

Independent claim 39 is directed to a method for receiving a command input. The method in claim 39, as amended, comprises, *inter alia*, “determining, responsive to the motion stopping, whether the motion of the stylus corresponds to a first motion from a plurality of predefined motions....” Consistent with claim 39, the specification discloses an illustrative embodiment in which each time the motion of a pen is detected to stop, the recorded coordinates of the pen motion are evaluated by a gesture recognizer (See, e.g., Specification, pg. 12, lines 8-11).

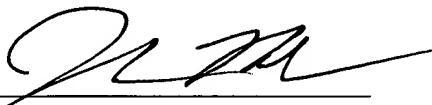
In contrast, the Doval system requires the user to select an object in order to initiate the function or program associated with the object (Doval, col. 4, lines 14-19). Thus, Doval does not teach or suggest determining, responsive to the motion of a stylus stopping, whether the motion corresponds to a first motion from a plurality of predefined motions. Indeed, Doval is silent as to the motion of a stylus stopping.

Claim 40, which depends from claim 39, is also allowable for at least those reasons that claim 39 is allowable, and further in view of the additional features recited therein.

Conclusion

All rejections having been addressed, it is submitted that the present application is in condition for allowance, and a notice to that effect is respectfully requested. Should the Examiner feel that a telephone conference would expedite prosecution, she is invited to contact the undersigned at the number below.

Respectfully submitted,

By: 
Jordan N. Bodner
Registration No. 42,338

BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001
Telephone: (202) 824-3150
Facsimile: (202) 824-3150

Date: August 6, 2003